

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED

Paper No. 865

JUN 18 1999 UNITED STATES PATENT AND TRADEMARK OFFICE

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CHI-CHUNG WANG, TERRY C. EISENSMITH, CHARLES E. KIERNAN
AND ROBERT L. MILANESE

Junior Party,¹

v.

JAMES R. BURROUGHS AND ALAN N. O'KAIN (REISSUE)

Senior Party,²

JAMES R. BURROUGHS AND ALAN N. O'KAIN (PATENT)

Senior Party.³

¹ Application 07/730,712, filed July 16, 1991. Assignors to Duracell International Inc.

² Reissue Application 07/963,915, filed October 20, 1992. Accorded Benefit of U.S. Application No. 07/308,210, filed February 8, 1989, now Patent No. 5,015,544, issued May 14, 1991. Assignors to Strategic Energy Ltd.

³ Application 07/308,210, filed February 8, 1989, now U.S. Patent No. 5,015,544, issued May 14, 1991. Assignors to Strategic Energy, Ltd.

Interference No. 103,036

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FINAL HEARING: April 21, 1999

Before URYNOWICZ, SOFOCLEOUS and METZ, Administrative Patent Judges.

SOFOCLEOUS, Administrative Patent Judge.

The subject matter of this interference relates to a battery with a strength indicator. The count of this interference is as follows:

Count 1

A battery having a label with an integral voltmeter; wherein the voltmeter comprises:

- A) a dielectric layer;
- B) a conductive layer above or below the dielectric layer; and
- C) a temperature sensitive color indicator layer in thermal contact with the conductive layer, characterized in that 1) the conductive layer has i) sufficient heat generating capacity to affect a change in the temperature sensitive color indicator layer and ii) sufficient thermal insulating means under one of its surfaces to overcome heat sinking when the voltmeter is in contact with a battery having an electrically conducting housing and 2) the voltmeter includes means for forming an electrical switch with the electrically conductive battery housing.

The party Wang et al.'s claims 22 to 24 and 43 to 63, the party Burroughs et al.'s patent claims 1 to 11 and the party Burroughs et al.'s reissue claims 1 to 11, 13 to 16, 18 to 20, 22 to 33, 35 to 37 and 39 to 51 correspond to the count.

This is the second final hearing in this proceeding. At the time the first final hearing was held, this proceeding involved four parties, i.e., the party Wang et al. on its involved application, the party Tucholski on its involved application, the party Cataldi et al. on its involved patent and application, and the party Burroughs et al. on its involved patent and application. As a result of the first final hearing, the Board pursuant to its authority under 37 CFR § 1.658(a) entered three final decisions (Paper Nos. 801 to 803), issuing judgment against the junior parties Tucholski and Cataldi et al. and remanding this interference to the Administrative Patent Judge (APJ) for further proceedings as to the party Wang et al. As a result of the remand, the APJ set times for taking priority testimony. The junior party Wang et al. presented priority testimony; the senior party Burroughs et al. presented no testimony and elected to stand upon its February 8, 1989 filing date. Both parties filed briefs and appeared, through counsel, at final hearing.

ISSUES

The party Wang et al.'s opening brief raises the following issues⁴:

1. Pending motion no. 28 for additional discovery seeking the identification of any reduction to practice the party Burroughs et al. concedes in connection with its allegation of suppression and concealment.

⁴ These are the only issues raised by the party Wang et al. The party Wang et al. did not seek review of its preliminary motion nos. 8, 9, 11, and 13.

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2. Reconsideration of the party Wang et al.'s response to and request for clarification of Interlocutory Order No. 13 and supplement thereto (Paper Nos. 811 and 812) regarding the findings concerning claims corresponding to the count and the rulings thereon set forth in Interlocutory Order No. 14, dated April 21, 1998.
3. Whether the party Wang et al. has established priority of invention vis-à-vis the party Burroughs et al.

The party Burroughs et al. opening brief raises the following issues:

4. Whether preliminary motion nos. 5, 7 and 8 to substitute a broader count for count 1 should be granted.
5. Whether preliminary motion no. 1 for judgment against the party Wang et al. should be granted.
6. Whether we should exercise our discretion and designate the party Wang et al.'s application claims 25 to 31 as corresponding to the count, as requested on page 129 of the party Burroughs et al.'s opening brief.

I. Issue No. 1

The party Wang et al.'s motion no. 28 for additional discovery is dismissed as moot. The motion seeks the identification of any actual reduction to practice on behalf of the party Wang et al., which the party Burroughs et al. concedes in connection with its allegation of suppression and concealment. As is evident from the party Burroughs

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et al.'s opening brief, the party Burroughs et al. does not concede that the party Wang et al.'s record establishes an actual reduction to practice.

II. Issue No. 2

The party Wang et al. requests that we review its response to and request for clarification of Interlocutory Order No. 13 and the supplement thereto (Paper Nos. 811 and 812) regarding the APJ's findings concerning claims corresponding to the count and the rulings thereon set forth in Interlocutory Order No. 14, dated April 21, 1998. The request for clarification urges that the party Burroughs et al.'s reissue claims 31 and 50 should not be designated as corresponding to the count because these claims were held to be indefinite under 35 U.S.C. § 112, second paragraph. The supplement urges that the party Burroughs et al.'s reissue claim 47 should not be designated as corresponding to the count because the claim was held to be unpatentable under 35 U.S.C. § 112, first paragraph, and that the party Burroughs et al.'s reissue claims 13 and 30 should not be designated as corresponding to the count because these claims embrace switches which are not membrane switches.

In his decision, Interlocutory Order No. 14, the APJ considered the foregoing matters and denied the relief requested by the party Wang et al. The APJ's order is presumed to have been correct and the burden is upon the party Wang et al. to show why it should be modified. Nowhere does the party Wang et al.'s opening brief address the reasons given by the APJ for the denial or show why we should exercise our

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authority under 37 CFR § 1.655(a) to modify the APJ's decision. Consequently, since the party Wang et al. has not sustained its burden to show any error in the order, we decline to modify it.

III. Issue No. 4

The party Burroughs et al. opening brief requests that we grant its preliminary motion nos. 5, 7 and 8 to substitute a broader count for count 1. In our view, these motions are moot.

While we agree with the party Burroughs et al. that it is the settled interference practice that the count of an interference should be broad enough to embrace a party's proofs for priority and that the count of the interference should not be narrower than an allowable claim designated as corresponding to the count, we perceive of no reason as to why we should now change the count, where neither party is prejudiced by the present count. The senior party Burroughs et al. certainly is not prejudiced since it did not take any priority testimony.

IV. Issue No. 6

On page 129 of its opening brief, the party Burroughs et al. request that we exercise our discretion to designate the party Wang et al.'s application claims 25 to 31 as corresponding to the count. It was incumbent upon the party Burroughs et al. to file a preliminary motion under 37 CFR § 1.633(c)(3) to redefine this interference if the party desired to have the aforesaid claims added to this interference. However, the

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party Burroughs et al. did not file such a preliminary motion, nor has the party Burroughs et al. explained its failure to do so. 37 CFR § 1.656(b) (1995) . For these reasons, we decline to exercise our discretion.

A PRELIMINARY MATTER CONCERNING
THE REDECLARATION OF THIS INTERFERENCE

Pages 11 and 12 of the Final Decision with Respect to the Party Cataldi et al. (Paper No. 802) describe the events leading to the redeclaration of this interference. The pertinent section of the decision reads as follows:

On December 30, 1992, this interference was declared between the Wang et al. application and the Cataldi et al. patent. Thereafter, the interference was redeclared on August 19, 1994, by adding the Tucholski application, the Cataldi et al. reissue application and the Burroughs et al. reissue application, the Burroughs et al. patent not being involved in the proceeding. After the redeclaration of the interference, counsel for the party Cataldi et al. initiated a telephone conference call with both Judge Smith, the APJ then in charge of the interference, and counsel for the party Burroughs et al. During the conference call, counsel for the party Cataldi et al. requested that the Burroughs et al. patent be added to this interference, because both the Cataldi et al. reissue application and patent were involved in this interference whereas the Burroughs et al. patent was not. As a result of the conference call, Judge Smith redeclared the interference (Paper No. 51, mailed September 14, 1994) by adding the Burroughs et al. patent.

The Redeclaration Notice of September 14, 1994, however, contains a clerical error with respect to the claims which are designated as corresponding to the count. The Redeclaration Notice designates the party Burroughs et al.'s patent claims 1 to 11 as corresponding to the count, but does not designate the same claims, which are

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present in the Burroughs et al. reissue application, as corresponding to the count. If the party Wang et al. was to establish priority of invention vis-à-vis the party Burroughs et al., claims 1 to 11 of the Burroughs et al. patent would be cancelled pursuant to 35 U.S.C. § 135(a), and the party Burroughs et al. would not be entitled to those claims in its patent or its reissue application. Thus, to correct this clerical error, we are redeclaring this interference by designating the reissue claims 1 to 11 as corresponding to the count.

On page 1, note 1 of its opening brief and on page 1, note 2 of its reply brief, the party Wang et al. argues that the Burroughs et al. patent claims 1 to 11 should not have designated as corresponding to the count. The argument, however, is inconsistent with the position taken by the party Wang et al. earlier in this proceeding. After the interference was redeclared on September 14, 1994, the party Wang et al. did not file a request for reconsideration with respect to the Redeclaration Notice's designation of the Burroughs et al. patent claims 1 to 11 as corresponding to the count. Nor did the party Wang et al. file a preliminary motion under 37 CFR § 1.633(c)(4) to designate those patent claims as not corresponding to the count. Rather, the party Wang et al. took a contrary position, i.e., that those patent claims were properly designated as corresponding to the count. See the party Wang et al.'s comments (Paper No. 227) in opposition to the party Cataldi et al.'s preliminary motion no. 1 to designate the Burroughs et al. patent claims 1 to 11 as not corresponding to the count. In the

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comments, the party Wang et al. states, "Claims 1-11 of Burroughs '544 patent and Burroughs Reissue claims 13-32, 34-36 and 38-51 define the same inventions defined by other claims designated as corresponding to count 1 of the interference, and are not new and unobvious there over under 37 C.F.R. § 1.601(n)."

Thus it appears that at the time this interference was redeclared by adding the Burroughs et al. patent, the party Wang et al. was of the view that claims 1 to 11 of the Burroughs et al. patent defined the same patentable invention as the count and took this position during the motion period. The party Wang et al.'s present position in its opening brief and reply brief is inconsistent with the position taken earlier in this proceeding. A party's change in position, such as here, is considered improper, especially where the party obtains a judicial benefit on its previous position.

Cf. Bosies v. Benedict, 27 F.3d 539, 543, 30 USPQ2d 1862, 1866 (Fed. Cir. 1994). In this case, the benefit obtained by the party Wang et al. is to have all the Burroughs et al. patent claims designated as corresponding to the count so that if the party Burroughs et al. loses the priority contest, the party Burroughs et al. would lose all of its patent claims designated as corresponding to the count.

Since claims 1 to 11 of the Burroughs et al. reissue application are identical to claims 1 to 11 of the Burroughs et al. patent which are designated as corresponding to the count, the reissue claims also define the same patentable invention as the count. Accordingly, in view of the foregoing, we are correcting the error in the redeclaration

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notice of September 14, 1994 by designating the Burroughs et al. reissue application claims 1 to 11 as corresponding to the count.

It has also come to our attention that the Redeclaration Notice, dated December 22, 1998 (Paper No. 843), also contains a clerical error. Burroughs et al. reissue claims 31 and 50 were inadvertently omitted from the table identifying the claims corresponding to the count. Compare the notice of September 14, 1994 with the notice of December 22, 1998. We are also correcting this error.

THE PARTY WANG ET AL.'S CASE FOR PRIORITY

As the junior party, the party Wang et al. has the burden to establish priority of invention prior to the February 8, 1989, filing date of the involved Burroughs et al. patent. On pages 29 and 30 of its opening brief, the party Wang et al. urges that its record establishes an actual reduction to practice prior to February 8, 1989 which has not been abandoned, suppressed or concealed; or alternatively that its record establishes prior conception with diligence from a time just prior to February 8, 1989 to a subsequent actual or constructive reduction to practice.

Before we evaluate the party Wang et al.'s record, we must decide (i) the burden of proof (preponderance of the evidence or clear and convincing evidence) upon the party Wang et al. and (ii) the party Burroughs et al. motion to suppress testimony and associated evidence.

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Burden of Proof

Since the Wang et al. application was filed after the issuance of the involved Burroughs et al. patent, the burden of proof upon the party Wang et al. is to show priority of invention by clear and convincing evidence. Price v. Symsek, 988 F.2d 1187, 1194, 26 USPQ2d 1031, 1036 (Fed. Cir. 1993).

On page 29 of its opening brief and on pages 1 and 2 of its reply brief, the party Wang et al. urges that its burden of proof as to the copending Burroughs et al. reissue application is to show priority of invention by a preponderance of the evidence whereas its burden of proof with respect to the Burroughs patent is to show priority of invention by clear and convincing evidence, citing Bruning v. Hirose, 161 F.3d 681, 48 USPQ2d 1734 (Fed. Cir. 1998). This position is not considered well taken. There can be only one burden of proof with respect to a senior party, not two burdens of proof. In this case, the senior party is a patent issued before the junior party's application was filed and in that circumstance the burden of proof is by clear and convincing evidence.

Price v. Symsek, 988 F.2d at 1194, 26 USPQ2d at 1036. See also 37 CFR § 1.657(c).

The fact that the senior party also filed a reissue application which is copending with the junior party's application and which is involved in the interference does not change the fact that the senior party is an issued patent. The Bruning decision is inapposite since it does not concern a senior party who is involved in an interference on both a patent and

a reissue application where the patent issued before the filing date of a junior party's application and the reissue application is copending with the junior party's application.

Accordingly, we hold that the burden of proof upon the party Wang et al. is to show priority of invention vis-à-vis the party Burroughs et al. by clear and convincing evidence.

Motion to Suppress

In the motion, the party Burroughs et al. request that certain evidence (testimony and exhibits) introduced into the record by the party Wang et al. should be suppressed. This evidence concerns changes⁵ made by the party Wang et al. via the correspondence of August 4, 1998 and during the cross-examination of the party Wang et al.'s declarants between September 9 to 17, 1998, the introduction of new exhibits⁶ during the cross-examination of the declarants, and serving additional declarations with respect to the original declarations.

The motion is considered procedurally defective, because the motion does not show where the party Wang et al.'s opening brief is relying upon the evidence sought to

⁵ These changes concern supplying or correcting the identification of certain documentary evidence relied upon in the original declarations.

⁶ The exhibits, WE 465 to 469, were produced by the party Wang et al. as a result of a request under 37 CFR § 1.687(b) by the party Burroughs et al. and introduced into evidence during the deposition of Mr. Garris. Under this circumstance, the party Wang et al. is entitled to rely upon the exhibits. Cf. Clark v. Wilke, 203 USPQ 1101, 1104 (Bd. Pat. Int. 1978).

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be suppressed. To the extent that the motion seeks to suppress evidence, which is not relied upon by the party Wang et al. in its opening brief, the motion is dismissed as moot.

To the extent that the motion seeks to suppress evidence which is relied upon by the party Wang et al. in its opening brief, the motion is denied. The former junior parties Tucholski and Cataldi et al. are involved in two civil actions under 35 U.S.C. § 146. These civil actions also involve the parties Wang et al. and Burroughs et al. Undoubtedly, the losing party of this interference will file either an appeal pursuant to 35 U.S.C. § 141 to the Court of Appeals for the Federal Circuit or commence a new civil action pursuant to 35 U.S.C. § 146. Since the evidence which is the subject of the motion to suppress and which is relied upon by the party Wang et al. in this proceeding may also be relied upon in the civil action, we decline to suppress that evidence so that the court may have the benefit of our views on the evidence to the extent that we rely upon that evidence.

The Party Wang et al.'s Record

The party Wang et al. presented a record consisting of the testimony of 8 witnesses together with 406 associated exhibits. The testimony will be referred to by WR followed by its page number; each exhibit, by WE followed by its number. Testifying on behalf of the party Wang et al. are Messrs. Terry C. Eisensmith and Robert L. Milanese, two of the four named inventors, and Messrs. Ronald S. Cornell,

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Gregg A. Dwyer, Michael C. Garris, Wilfred F. Saint, Paul Stratton and William Tinsley, non-inventor witnesses. All the witnesses testifying were employees of Duracell, the assignee of the involved Wang et al. application, during the relevant time period.

The party Wang et al. urges that its record establishes two actual reductions to practice,⁷ the first in May 1986 and the second in June 1988.

In the early part of August 1985, Mr. Milanese became aware of the availability in the market of a tester for batteries (BATCHECK©) via a letter (WE 80) from Bob Parker to Mr. Saint. WR 258. The letter contained information about the BATCHECK© tester and referenced Mr. Parker's U.S. Patent No. 4,006,414. Mr. Saint, who was Vice President of Marketing and Product Development, requested that Mr. Milanese learn more about the BATCHECK©. WE 86 is a photocopy of both sides of a BATCHECK© tester. Mr. Milanese met with Mr. Parker to discuss the BATCHECK© tester and the basic technology and to evaluate the benefits and drawbacks of the battery tester sought to be protected by Mr. Parker's patents. WR 258, 259 and 263; WE 86. After meeting with Mr. Parker, Mr. Milanese recommended that Duracell encourage a working relationship with Mr. Parker. WR 259.

⁷. On page 41 of its opening brief, the party Wang et al. alludes to the fact that APJ Smith had held that its affidavit showing under §§ 1.608(b) and 1.617 was sufficient. That fact only established that the showing was sufficient to have this interference proceed, but does sustain the party Wang et al.'s burden to establish priority by clear and convincing evidence. Cf. Wiesner v. Weigert, 666 F.2d 582, 586, 212 USPQ 721, 725 (CCPA 1981); Baukus v. Saito, 203 USPQ 155, 157 (Bd. Pat. Int. 1979).

Concerning the BATCHECK®, Mr. Milanese testified at WR 262 and 263 as follows:

The BATCHECK as enumerated above, was a voltmeter that comprises a dielectric layer, a conducting layer above (or below) the dielectric layer, and a temperature sensitive color indicator layer in thermal contact with the conductive layer.

The BATCHECK is so designed that when in use the conductive layer has: i) sufficient heat generating capacity to effect a change in the temperature sensitive color indicator layer, and ii) sufficient thermal insulating means under one of its surfaces to overcome heat sinking when the voltmeter is in contact with a battery having an electrically conductive housing and that the voltmeter includes means which, when contacted with the electrically conductive battery housing, completes a circuit, thereby providing an indication as a result of the resistive heating of the thermochromic element.

...

14) The circuit elements of the tester were conveniently constructed in a unitary film strip having dimensions and contacts adapted for use with various size batteries of commerce. Utilization merely required contact with the battery terminals; the contact points were so arranged that in use there was a space between the battery and the tester; i.e., the flexible film strip bowed to accommodate the cell.

On April 28 and 29, 1986, Mr. Kiernan scheduled a "head session" among key executives in order to identify new product ideas, or means for improving Duracell's existing products. In particular, Mr. Kiernan suggested a means for helping the consumer to determine battery freshness, as well as the useful life remaining in batteries that have been discharged to some extent. The report of that meeting (WE 88) shows that Mr. Kiernan would have responsibility for a project named "Project Fresh," a project directed to making an on-cell tester and an on-package tester. A

subsequent memo (WE 89), dated May 8, 1986 from Mr. Kiernan to the president of Duracell, reports the results of the meeting and directed that Mr. Milanese take working responsibility for the project, including investigation of the technical aspects of known battery testers. WR 4, 63, 64, 260, 261, 269, 381 to 383, 481 and 482. With respect to the on-cell tester, the research project can be broken down into two phases.

The First Phase

As a result of discussions with Mr. Kiernan, Mr. Milanese suggested that a tester could be made part of the cell jacket (label) and memorialized concepts for realizing this objective in his memo of May 21, 1986 to Mr. Ken Macey (WE 90). WR 261.

Mr. Milanese testified that in May 1986 he assembled a prototype on-cell tester⁸ by cutting a window in a battery label and fixing a resistive heating/thermochromic type BATCHECK® tester in the window using adhesive tape. WE 262. He shortened both ends of the BATCHECK® to be about ½ inch longer than the length of a D battery label, and removed a portion of the electrical insulating layer to expose the conductive silver on the contact ends so that the contact ends would be means for closing a circuit. WR 263 and 264. He testified that based on his assembled and working prototype, he knew "that an on-cell tester having the voltmeter integral with the label could be made

⁸ Page 47 of the party Wang et al.'s opening brief characterizes this prototype as "a relatively simple device".

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into a commercial product," but that certain engineering considerations had to be worked out before a commercial product could be completed. WR 265. He testified that WE 87 is a sketch of the prototype, and acknowledged that WE 87 is not signed or dated and that he could not remember when WE 87 was prepared. WR 316.

Mr. Cornell, the chief patent counsel for Duracell, testified that on February 10, 1988 he received and read a memo (WE 184), dated February 9, 1988, from Mr. Milanese and that this memo refers to an earlier memo, dated May 21, 1987, which describes ideas relating to battery testers. WR 13 and 14. Mr. Cornell also testified that on or about April through May of 1988, he visited with Mr. Milanese and observed the successful operation of a prototype on-cell tester; actuated the tester and saw the tester indicate the presence of voltage in the battery with which it was integrated. WR 14. Mr. Cornell testified that he held and operated the on-cell tester, that he knew that it was assembled with a BATCHECK® tester, and that the on-cell tester did not include a switch. WR 15 and 16.

On June 4, 1987, Duracell filed on behalf of Messrs. Kiernan and Milanese as joint inventors of an application, Serial No. 058,059, which issued on February 9, 1988 as U.S. Patent No. 4,723,656. This patent discloses an on-package tester and does not include any disclosure or suggestion of an on-cell tester. Mr. Milanese acknowledged that the structure and function of the on-cell tester was complete prior to the execution of the application for the '656 patent. He testified at WR 284 as follows:

[P]rior to our execution of the formal papers for the on-package embodiment in May of 1987, we were possessed of a structural delineation of the on-cell tester corresponding to its functional requirements, albeit insufficient to direct the application of the technology in a commercial manufacturing process.

Mr. Milanese also testified that in April 1987, the project (on-cell tester) was placed on hold for technical reasons, and a reassessment was undertaken by A.D. Little, an outside consultant, to review the entire project. WR 285 and 288.

Mr. Eisensmith testified that all work on Project Fresh on-package and on-cell testers was discontinued from mid-1987 to May of 1988. WR 172 and 173; WE 197. Mr. Saint testified that he was not aware of any work on the on-cell tester during the period from mid-1987 through early 1988. WR 415.

II

We hold that during the first phase of activity the Wang et al. record does not establish actual reduction to practice.

It is well settled that a reduction to practice must include every limitation of the count. NewKirk v. Lulejian, 825 F.2d 1581, 1582, 3 USPQ2d 1793, 1794 (Fed.Cir. 1987); Land v. Regan, 342 F.2d 92, 101, 144 USPQ 661, 669 (CCPA 1965) and Schoenwald v. Woltersdorf, 226 USPQ 446, 447 (Bd. Pat. Int. 1984).

Concerning the prototype on-cell tester made in May 1986, the party Burroughs et al. contends that since there are no contemporaneous documents or prototypes to support the oral testimony of Messrs. Milanese and Cornell, we should give that

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testimony little weight. We decline to do so, since it is well settled that a party to an interference can prove priority of invention by oral testimony alone. Lustig v. Legat, 154 F.2d 680, 682, 69 USPQ 345, 348 (CCPA 1946). We agree with the party Wang et al.'s position on page 47 of its opening brief that the prototype on-cell tester is a "relatively simple device" and for that reason, we have no reason to disbelieve the oral testimony, even though the burden of proof is by clear and convincing evidence. Cf. Schwartz v. Graenz, 81 F.2d 767, 776, 28 USPQ 386, 394 (CCPA 1936) (The record should be carefully scrutinized where a witness testifies about an oral communication which occurred many years earlier, where the invention is a complex device and where no detailed figures or other contemporaneous exhibits exist showing each feature of the concept.)

We agree with the party Burroughs et al. that the prototype on-cell tester made by Mr. Milanese does not constitute an actual reduction to practice, because the prototype contains no switch. WR 266. In fact, Mr. Milanese acknowledges this and his testimony is consistent with the testimony⁹ of Messrs. Palmer and Barnett, experts testifying on behalf of the party Wang et al. These experts testified that the Sterling patent did not disclose or suggest the use of a switch, i.e., clips 9 and 10 of the Sterling patent do not act as a switch when attached to the battery posts 11 and 12. WR 1468

⁹ See pages 17 to 24 of the Final Decision (Paper No. 801) which holds that the Burroughs et al. claims would not have obvious under 35 U.S.C. § 103 over the Sterling patent in view of other prior art.

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to 1470, 1480 and 1481. The BATCHECK© device has contact tabs for contacting the anode and cathode ends of a battery cell. These tabs are analogous to the clips of the Sterling tester and do not act as a switch.

For the foregoing reasons, we hold that the first phase activity does not constitute actual reduction to practice on behalf of the party Wang et al.

III

Without an actual reduction to practice, there is no invention which can be abandoned, suppressed or concealed. Peeler v. Miller, 535 F.2d 647, 651, 190 USPQ 117, 120 (CCPA 1976). For the sake of completeness, assuming that the first phase constituted an actual reduction to practice, then we agree with the party Burroughs et al. that the party Wang et al. abandoned, suppressed or concealed its invention.

It is well settled that if a junior party relies upon an actual reduction to practice and if the hiatus in time between the date for its asserted actual reduction to practice and filing of its application is unreasonably long, the hiatus may give rise to an inference that the junior party suppressed or concealed the invention. Lutzker v. Plet, 843 F.2d 1364, 6 USPQ2d 1370 (Fed.Cir. 1988); Paulik v. Rizkalla, 760 F.2d 1270, 226 USPQ 224 (Fed. Cir. 1985); Shindelar v. Holdeman, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980), cert. denied, 451 U.S. 984 (1981); Peeler v. Miller, 535 F.2d at 647, 190 USPQ at 117; Young v. Dworkin, 489 F.2d 1277, 180 USPQ 388 (CCPA 1974); Holmwood v. Cherpek, 2 USPQ2d 1942 (Bd. Pat. App. & Int. 1986). Each case of

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concealment and suppression must be decided on its own particular set of facts.

Shindelar v. Holdeman, 628 F.2d at 1343, 207 USPQ at 117.

As noted by the court in Peeler v. Miller, 535 F.2d at 654, 190 USPQ at 122:

[A] four-year delay from the time an inventor is satisfied with his invention and completes his work on it and the time his assignee-employer files a patent application is, prima facie, unreasonably long in an interference with a party who filed first.

In this case, the relevant time gap would be approximately five years and two months from the first actual reduction to practice in May 1986 up to July 16, 1991, the filing date of Wang et al.'s application. This hiatus in time is unreasonably long and raises the inference that Wang et al. suppressed or concealed the invention in view of the lack of activity on the invention as noted below.

Thus, assuming there was a reduction to practice by May 1986, the burden falls on Wang et al. to excuse, explain or justify the lack of activity. Lutzker v. Plet, 843 F.2d at 1364, 6 USPQ2d at 1370. In our view, the party Wang et al. has not sustained its burden.

Here, Mr. Milanese testified that he knew that the on-cell tester made by him in May 1986 could be made into a commercial product and that certain engineering considerations had to be worked out. Mr. Milanese's testimony evinces a conviction on behalf of the inventors that they believed that they had a workable invention.

Mr. Milanese also testified that by May 1987, the date of filing of the Kiernan application, the inventors knew that the structure and function of an on-cell tester was

complete, but "insufficient to direct the application of the technology in a commercial manufacturing process." No disclosure of the on-cell tester was made in the Kiernan application. The Wang et al. record shows a lack of any activity directed to the on-cell tester during the period from mid-1987 up to May of 1988. Nowhere is this lack of activity for nearly one year explained. The record also shows other periods of inactivity, which will be addressed, infra, with respect to the second phase activity.

For the foregoing reasons, we hold that the party Wang et al. has not rebutted the presumption that they have suppressed or concealed the invention of the count.

The Second Phase

We have held that if the prototype on-cell tester made in May 1986 were an actual reduction to practice, then the party Wang et al.'s long period of inactivity raises the presumption that it has suppressed or concealed that reduction to practice.

Because of the suppression or concealment, the party Wang et al. cannot rely upon the prototype on-cell tester made in May 1986 as a reduction to practice, but may rely upon renewed activity prior to the senior party's entry into the field. As the Court noted in Paulik v. Rizkalla, 760 F.2d at 1272-73, 226 USPQ at 225-26:

There is no impediment in the law to holding that a long period of inactivity need not be a fatal forfeiture, if the first inventor resumes work on the invention before the second inventor enters the field. . . .

. . .

. . . There is no authority that would estop Paulik from relying on his resumed activities in order to pre-date Rizkalla's earliest date. We hold

that such resumed activity must be considered as evidence of priority of invention. Should Paulik demonstrate that he had renewed activity on the invention and that he proceeded diligently to filing his patent application, starting before the earliest date to which Rizkalla is entitled--all in accordance with established principles of interference practice-- we hold that Paulik is not prejudiced by the fact that he reduced the invention to practice some years earlier.

In this case, the party Wang et al. relies upon such renewed activities--a second reduction to practice during its second phase activity, and prior conception coupled with reasonable diligence up to its actual or constructive reduction to practice.

Mr. Eisensmith testified that he became involved with Tester, which is part of Project Fresh, at a meeting held prior to June 15, 1987. At that meeting, he was told about a program directed to incorporating a tester into Duracell's battery product. WR 116. He was told that the program had been run by Mr. Milanese, who had been responsible for the technical aspects of the tester program. Mr. Eisensmith was asked if he would be responsible for the technical aspects of the program. He agreed and became responsible for the Tester program during the first half of 1987. As part of his responsibilities, he became fully familiar with Mr. Parker's BATCHECK® tester, the elements of the tester and how the elements function. WR 117.

Mr. Eisensmith testified that after the June 15, 1987 meeting he had an independent conception of the invention of the count. WR 156. Concerning this conception, he testified at WR 156 and 157 as follows:

Q: Why don't you tell me what your initial conception was for an on-cell tester?

A: Well, there were two or three different versions, but the one I thought had the most significance was I took an actual tester off of a package and taped it to the side of a bare cell. And one side, obviously, had a contact with the battery can, and on the opposite side I put a piece of Scotch tape under it so it wouldn't be shorted.

Then I took a - - I said one side has an electrical connection. So what I needed there was to develop some kind of switching mechanism to turn it on and off. And the only thing I could come up with was some sort of external device. And I just happened to use a paper clip, because that was in my desk drawer at the time. It could have been a paper clip, a bobby pin, anything.

So I remember calling Mike Garris [to] my office and drew a couple of pictures up on our [white] board and [sic] kicked around a couple of ideas and [sic] put this little model together and [sic] proved the principle that it did work. That was pretty much all that was done with it.

Concerning the making of the prototype on-cell tester, Mr. Eisensmith testified at WR 123 and 124 as follows:

21) In June, 1988 Mike Garris and I were sitting in my office discussing the on-package tester and trying to imagine what next generation would be like. We knew that the ultimate goal of the project was to place a tester on every cell, and that the reason for developing the on package version first was because it was less complicated, yet the problems inherent in the on package version were much the same as those for the one cell version. I started to assemble a tester strip that was in my office onto a "D" cell, and thereby made my first working model of an on cell tester. Mike Garris was present with me in my office as I was constructing the first working model of the on cell tester. He was there when it was completed, and in Mike's presence I successfully actuated the prototype.

22) The prototype referred to in numbered paragraph 21 is no longer in existence. I recently drew a sketch that shows my recollection of the construction of the prototype. That sketch is attached as [WE 177].

23) I assembled the prototype on cell tester referred to in paragraph 21 and depicted in the drawing referred to in paragraph 22 by first scraping off the plastic that covered a first contact terminal of a tester strip to expose the outer surface of the conductive contact layer. I placed a piece of adhesive tape on the outside of the cylindrical wall of the battery where it would be positioned to insulate the tester strip from the cell wall. Then I attached the tester strip to the cylindrical wall of the cell over the adhesive tape with the second terminal of the tester positioned over and held in electrical contact with one terminal of the battery. I completed an electrical circuit constituted by the cell and the tester strip to thereby actuate the tester by using a paper clip to electrically connect the outer surface of the first contact terminal of the tester with the other terminal of the battery.

Mr. Garris testified that he observed Mr. Eisensmith assemble and successfully operate the prototype on-cell tester. WR 187. With respect to the prototype on-cell tester, Mr. Garris testified at WR 188 as follows:

(7) That the voltmeter of the device referred to in paragraph 6 above was a tester strip as then available from Project Fresh. The voltmeter was attached to the label on the battery via adhesive tape. One end of the voltmeter was in contact with the battery can. The opposite end of the voltmeter was connected to the other terminal of the battery with a switch formed from a connecting metal element, in this case, an extended paper clip: one end of the paper clip was contacted with the tester strip; and the other end was contacted with the other terminal of the battery to complete the connection, upon which I observed successful actuation of the prototype.

II

We hold that during the second phase of activity the Wang et al. record does not establish actual reduction to practice on behalf of the Wang et al. inventors identified in the preliminary statement.

Concerning the prototype on-cell tester made in June 1988, the party Burroughs et al. contends that there are no contemporaneous documents or prototypes to support the oral testimony of Messrs. Eisensmith and Garris and that the testimony concerns events taking place more than ten years prior to their testimony. As we noted earlier, it is well settled that a party to an interference can prove priority of invention by oral testimony alone. Lustig v. Legat, *supra*. We agree with the party Wang et al.'s position on page 47 of its opening brief that the prototype on-cell tester is a "relatively simple device" and, for that reason, we have no reason to disbelieve the oral testimony, even though the burden of proof is by clear and convincing evidence. Cf. Schwartz v. Graenz, 81 F.2d at 776, 28 USPQ at 394.

We agree with the party Wang et al. that the prototype on-cell tester made by Mr. Eisensmith meets every limitation of the count. We reject the party Burroughs et al.'s argument that since Mr. Garris testified that he "observed successful actuation of the prototype," that the device was not shown to indicate the presence of voltage in the battery. We consider that the foregoing testimony is sufficient to show the prototype on-cell tester was operational for its intended purpose. Indeed, Mr. Garris testified that Mr. Eisensmith successfully operated the device.

Notwithstanding the foregoing, we agree with the party Burroughs et al. that the prototype does not constitute an actual reduction to practice on behalf of Chi-Chung Wang, Charles E. Kiernan and Robert L. Milanese, the Wang et al. inventors identified

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by the party Wang et al.'s preliminary statement as the inventors of the subject matter of the count. Cf. Kilbey v. Thiele, 199 USPQ 290, 296 (Bd. Pat. Int. 1978) (A party's burden in an interference is to prove priority on behalf of the inventors identified in its preliminary statement.) See also 37 CFR § 1.622(a) which requires¹⁰ a party to identify the inventor(s) who made the invention defined by the count. Here, Mr. Eisensmith testified that he conceived and reduced to practice the subject matter of the count and his testimony was corroborated by Mr. Garris. Moreover, it is settled that the reduction to practice must have been made by the inventor himself, or by one authorized to do so either by the inventor or by one who acquired the inventor's rights to the invention. 1 Rivise and Caesar, Interference Law and Practice, § 134, page 399 (The Michie Co. 1940). Here, the record contains no evidence to show that the reduction to practice made by Mr. Eisensmith was on behalf of, or at the direction of, the inventors of the count, as identified by the preliminary statement. To the contrary, the Wang et al. record shows that Mr. Eisensmith believed that he, himself, was the inventor of the subject matter of the count.

For the foregoing reasons, we hold that the second phase activity does not constitute actual reduction to practice on behalf of the party Wang et al.

¹⁰ The preliminary statement identifies a party's inventors of the subject matter of a count, thus notifying the opponent of what witness the party may or may not rely upon as a corroborating witness for conception and reduction to practice. Cf. Manny v. Garlich, 135 F.2d 757, 768, 57 USPQ 377, 388 (CCPA 1943).

III

Without an actual reduction to practice, there is no invention which can be abandoned, suppressed or concealed. Peeler v. Miller, supra. For the sake of completeness, assuming that the second phase constituted an actual reduction to practice on behalf of the party Wang et al., which it does not, then we hold that there was no specific intent to abandon, suppress or conceal the invention by the party Wang et al. and that the evidence raises an inference of suppression of the invention by the party Wang et al.

In this regard, the evidence shows a three-year delay from the reduction to practice in June 1988 up to filing the involved Wang et al. application on July 16, 1991.

The following testimony is considered pertinent to whether this hiatus raises the inference of suppression or concealment.

Mr. Eisensmith testified that his 1988 on-cell prototype was a functional device, but not something that could be commercialized. WR 168 and 169. Similarly, Mr. Dwyer testified that an on-cell tester was not technically feasible and that he was not satisfied that it could be done at a reasonable commercial cost and that for commercial use the tester did not have the degree of reliability for the consumer. WR 96 and 97.

Mr. Eisensmith testified that very little technical work was done on the on-cell tester from the period from mid-1988 to the end of 1990, but rather, work was

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concentrated on the on package tester and developing all the subsequent cell types.

WR 168. Mr. Garris testified that in the period from 1986 to late 1990 the on-package tester had primacy where development efforts were concerned. WR 188. The decision to proceed with the development work for the on-package tester at the expense of the development work for the on-cell tester was based solely on commercial considerations. Mr. Dwyer testified that it was much easier to introduce an on-package tester in terms of volumes, with respect to reliability and it was much easier to do commercially. WR 86 and 87.

In late 1990, the on-package tester had gone on sale to the public. WR 170. In November 1990, Mr. Eisensmith met with Mr. Cornell to discuss developments relating to the tester and Mr. Cornell suggested that it was timely to file a patent disclosure on the tester embodiment. On November 15, 1990, Mr. Eisensmith signed a formal invention disclosure (WE 405). WR 125. On July 16, 1991, the involved Wang et al. application was filed.

We note that the foregoing evidence shows a lack of significant activity on the on-cell tester for approximately two and one half years from the reduction to practice in June 1988 up to November 1990. We agree with the party Burroughs et al. that this lack of significant activity raises the inference of suppression or concealment.

Consequently, the burden falls on the party Wang et al. to rebut the inference that it suppressed or concealed the on-cell tester. To rebut the inference, the party Wang et al. urges that it was perfecting its invention before filing the involved application.

It is well settled that an inference of suppression or concealment may be overcome with evidence that the reason for the delay was to perfect the invention. Lutzker v. Plet, 843 F.2d at 1367, 6 USPQ2d at 1372. However, when the delay is caused by working on refinements and improvements which are not reflected in the final patent application, the delay will not be excused. Horwath v. Lee, 564 F.2d 948, 952, 195 USPQ 701, 706. Further, when the activities which cause the delay go to commercialization of the invention, the delay will not be excused. Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959).

On page 35 of its opening brief, the party Wang et al. urges that the improvements made and experienced with the development of the on-package tester were applied in relation to the further development of the on-cell tester. It is urged that "in or about September through October 1989, intensive efforts were underway to perfect the on-cell embodiment, requiring ultimately implementation of a flat wrap approach to the label," but that problems remained, "significantly involving heat sinking and the reliability of the liquid crystal." On page 39 of the opening brief, the party Wang et al. urges that in order to benefit the public, the construction of the device (on-package and on-cell

testers) needed to be consistent with modern manufacturing practices and constraints and the need for reliability of performance.

On pages 57 and 58 of its opening brief, the party Wang et al. refers to the testimony of Mr. Garris at WR 195 to 198, which is to the effect that in December 1988 efforts were made to identify potential resistors, inks for the temperature display (liquid crystal were then envisioned) and for graphics; that throughout January 1989, development work on various ink formulations continued, resistive elements suitable for the indicator were evaluated, and work on the substrate upon which the resistive elements was to be placed; and that in February 1989 various heat seal tests were run on testers, long term storage effects under various environmental conditions were run, and different liquid crystal ink formulations were evaluated. On page 59 of the brief, the party Wang et al. refers us to WE 251, 252 and 189 to show development efforts to improve the tester element itself. The brief notes that upon the receipt and testing of a new thermochromic ink in the August to October 1989 timeframe, it was determined to replace the liquid crystal in 9-volt batteries, that in September to October 1989 it was determined to use a flat wrap to overcome the heat sinking problem, and that changes to the contact pad area were done.

The involved Wang et al. application contains a generic disclosure. With respect to battery condition indicators, the Wang application incorporates by reference numerous patents, cited on pages 1 to 4 and page 8, lines 8 to 19, and the copending

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U.S. application Serial No. 652,165, now U.S. Patent No. 5,128,616, for their teachings of various indicator materials, including a thermochromic material. With respect to the insulating material, the application teaches as follows:

Insulating layer 18 can be made from any insulating material such as polyester, PVC, polyolefins, fiberglass, glass, rubber, polycarbonate, paper, cardboard, and the like formed into a sheet. Layer 18 preferably has dimensions which are sufficient to insulate the intermediate portion of the conductive deposit from the cell container. The thickness of layer 18 should be the minimum necessary to permit condition indicator 12 to function properly so that the combined thicknesses of the insulator and condition indicator are kept to a minimum. [Page 10, the last line to page 11, line 8.]

With respect to the substrate material for the condition indicator, the application in the paragraph bridging pages 13 and 14 teaches the use of thermoplastics such as polyolefins, polyhalohydrocarbons, and rubber.

Nowhere does the party Wang et al.'s opening brief point out where the involved Wang et al. application specifically discloses the perfections or improvements made during this period of time. From December 1988 to October 1989, the party Wang et al. was working to commercialize the on-package tester. The party Wang et al. urges that the work on the on-package tester should also be credited to refining and improving the on-cell tester. If, indeed, the party Wang et al. was refining or improving the on-cell tester, then the party should have specifically disclosed the improvements made by them. For example, the party should have disclosed the specific insulating material coupled with its recommended thickness. To disclose that the thickness of material

should be the minimum necessary to permit the condition indicator to function properly so that the combined thicknesses of the insulator and condition indicator are kept to a minimum is not sufficient, considering that the party Wang et al. urges that it expended a large amount of resources to determine the type of insulating materials, et seq., in order to refine and improve its invention. Likewise, the party should have disclosed the specific thermochromic inks found useful as indicator materials, since the party Wang et al. expended a lot of effort to determine the long term storage effect of various materials under various environmental conditions.

It is well settled that an application disclosure need not contain any examples. In re Borkowski, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970). However, where as here a party is attempting to rebut the inference of suppression or concealment on the basis of refining and improving an invention, the party should have incorporated into its application the specific refinements or improvements made by the party. Horwath v. Lee, 564 F.2d at 952, 195 USPQ at 706.

For the foregoing reasons, we hold that the party Wang et al. has not sustained its burden to rebut the inference of suppression or concealment.

Conception and Diligence

On pages 64 to 66 of its opening brief, the party Wang et al. speaks of the possibility that the Board might determine that one of its invention scenarios establishes conception. In that event, the party Wang et al. relies upon prior conception coupled

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with reasonable diligence just prior to February 8, 1989, the senior party's filing date, up to July 16, 1991, the filing date of the involved Wang et al. application.

It is well settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention. Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed.Cir. 1985).

In our view, the party Wang et al.'s record does not establish conception on behalf of the inventors identified in the party Wang et al.'s preliminary statement. As we noted above, the prototype on-cell tester made in May 1986 did not constitute an actual reduction to practice because the tester did not contain a switch. Likewise, the activities leading to the making of the May 1986 prototype do not establish conception because the inventors did not show possession of a switch. Likewise, as we noted above, the prototype on-cell tester made in June 1988 did not constitute an actual reduction to practice on behalf of the inventors identified in the party Wang et al.'s preliminary statement but rather was the independent invention of Mr. Eisensmith, who conceived and reduced to practice the invention on his own behalf. As we noted above, since Mr. Eisensmith did not work at the direction of the inventors of the party

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Wang et al. identified in its preliminary statement, there is no conception on behalf of the inventors identified in the preliminary statement.

Consequently, the Wang et al. record does not establish conception.

Assuming, for the sake of argument, that the record establishes conception, which it does not, then the party Wang et al. has the burden to show reasonable diligence from just prior to the senior party's filing date up to the filing of the involved Wang et al. application.

The reasonable diligence standard balances the interest in rewarding and encouraging invention with the public's interest in the earliest possible disclosure of invention and the party asserting reasonable diligence must account for the entire period from just prior to his opponent's entry into the field up to the party's reduction to practice. Griffith v. Kanamaru, 816 F.2d 624, 626, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987). In order to satisfy the reasonable diligence requirement of 35 U.S.C. § 102(g), the work must ordinarily be directly related to a reduction to practice of the invention of the count. Naber v. Cricchi, 567 F.2d 382, 385, 196 USPQ 294, 296 (CCPA 1977), cert.denied, 200 USPQ 64 (1978). Reasonable diligence may be shown by either affirmative acts toward a reduction to practice or acceptable excuses or reasons for failure of action. Hull v. Davenport, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937). A party may rely upon work on a related embodiment outside of the scope of the count for the purpose of diligence provided that the embodiment is a part of the party's

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invention and is disclosed in the party's application. Ginos v. Nedelec, 220 USPQ 831, 835 (Bd. Pat. Int. 1983). However, a party charged with diligence may not rely upon activities directed to another independent invention. Smith v. Crivello, 215 USPQ 446, 453 (Bd. Pat. Int. 1982).

Here, the party Wang et al. must show reasonable diligence for approximately twenty-nine months from just prior to February 8, 1989, the filing date of senior party, up to July 16, 1991, the filing date of the involved Wang et al. application. Nowhere does the party Wang et al.'s opening brief specifically set forth the daily activity performed by the party during this time period which is directed to the on-cell tester or set forth any reasons for any lack of activity during this period. See 37 CFR § 1.656(b)(5) and (6). Indeed, most of the activity during this period is directed to commercializing an independent invention, the on-package tester. In our view, the party Wang et al. may not rely upon its work to commercialize the on-package tester as diligence towards the filing of the involved application directed to the on-cell tester.

For the foregoing reasons, we hold that the party Wang et al. has not sustained its burden to show prior conception coupled with reasonable diligence.

Issue No. 5

The Burroughs et al. brief requests that we decide the Burroughs et al. preliminary motion no. 1 for judgment under 37 CFR § 1.633(a) that the party Wang et al.'s claims corresponding to the count are unpatentable over Burroughs et al.'s

involved patent. The motion is dismissed as moot inasmuch as we are issuing judgment against the party Wang et al. for the failure to establish priority of invention vis-à-vis the senior party Burroughs et al. As a result of the judgment, the party Wang et al. is not entitled to its claims corresponding to the count. Consequently, it is not necessary for us to decide whether the claims are also unpatentable over prior art.

JUDGMENT

On pages 2 and 3 of its opening brief, the party Wang et al. requests that we enter judgment against the Burroughs et al. reissue claims 17, 21, 31, 34, 38, 47 and 50, in accordance with pages 18 and 62 of the "Final Decision With Respect To The Party Cataldi et al." (Paper No. 802), judgment as to those claims having been deferred to this final hearing and request that we enter judgment against the Burroughs et al. reissue claims 13 and 30, in accordance with page 24 of the "Final Decision With Respect To The Party Tucholski" (Paper No. 801). We decline to issue judgment against reissue claims 13 and 30, since the final decision (Paper No. 801) did not hold those claims unpatentable but we will issue judgment against reissue claims 17, 21, 31, 34, 38, 47 and 50, since the final decision (Paper No. 802) did hold those claims unpatentable.

Since the Burroughs et al. reissue applicants canceled claims 17, 21, 34 and 38 in response to a preliminary motion for judgment, Burroughs et al., the reissue

applicants, are not entitled to the aforesaid claims. Burroughs et al., the reissue applicants, are not entitled to a patent containing claims 31, 47 and 50.

Judgment with respect to the subject matter of the count in issue is hereby awarded to James R. Burroughs and Alan N. O'Kain, the senior party. Accordingly, on the present record, Wang et al. is not entitled to a patent containing claims 22 to 24 and 43 to 63 corresponding to the count, Burroughs et al., the patentees, are entitled to a patent containing claims 1 to 11 corresponding to the count, and Burroughs et al., the reissue applicants, are entitled to a patent containing claims 1 to 11, 13 to 16, 18 to 20, 22 to 30, 32, 33, 35 to 37, 39 to 46, 48, 49 and 51 corresponding to the count.


ANDREW H. METZ
Administrative Patent Judge

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